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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,159	08/31/2000	Te-Kai Liu	YOR9-2000-0385US1	2619

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EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/652,159

Applicant(s)

LIU ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/12/04 has been entered.

Notice to Applicant

2. This communication is in response to the RCE filed on 01/12/04. Claims 1-20 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. (6,253,980), Whipp et al (2002/0022979) in view of Rosenberg et al (2003/0206117).

(A) As per claim 1, Murakami discloses a car rental system comprising:
a fleet of cars, each of which is operable only when a valid digital key

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is presented to the car, and each of said fleet of cars has a means to invalidate a digital key (See Murakami, Col.6, lines 29-67 to Col.7, line 63; Col.11, lines 5-57); and a management system for handling reservation and car return, said management system (See Murakami, Col.5, lines 57-67 to Col.6, line 28).

Murakami does not explicitly disclose a key generation system for generating digital keys for renters of the car rental system; a key return system for processing digital keys returned by renters.

However, these features are known in the art, as evidenced by Whipp. In particular, Whipp suggests a key generation system for generating digital keys for renters of the car rental system (See Whipp, Page 3, Paragraphs 0025-0029; Page 5, Paragraphs 0050-0053); a key return system for processing digital keys returned by renters (See Whipp, Page 3, Paragraphs 0025-0029; Page 5, Paragraphs 0050-0053).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Whipp within the system of Murakami with the motivation of providing a car rental system minimizing labor costs and local infrastructure support required to lease a vehicle from a remote site (See Whipp, Page 2, Paragraph 0015).

Murakami and Whipp do not explicitly disclose "wherein there exists no data communication link between the fleet of cars and the management system".

However, this feature is known in the art, as evidenced by Rosenberg. In particular, Rosenberg suggests "wherein there exists no data communication link

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between the fleet of cars and the management system" (See Rosenberg, Page 6, Paragraph 0071; Page 13, Paragraph 0199).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Rosenberg within the collective teachings of Murakami and Whipp with the motivation of providing no need for exchange of information between the vehicle location system control center and the central computer (See Rosenberg, Page 6, Paragraph 0071).

(B) As per claim 2, Whipp discloses the system further comprising a parking lot guarded by a security gate, said fleet of cars being parked within confines of said parking lot when not rented by a renter of the car rental system, said security gate only opening when a valid digital pass is presented by a renter of the car rental system (Page 6, Paragraph 0062-0064).

The motivation for combining the respective teachings of Murakami, Whipp and Rosenberg are as discussed above in the rejection of claim 1, and incorporated herein.

(C) As per claim 3, Whipp discloses the system wherein the management system is accessed by a prospective renter over a network and the prospective renter is given a digital key to operate a particular car and a digital pass to open the gate of the parking lot where said particular car is parked, after said prospective renter completes a reservation for said particular car, said digital key and digital pass being effective starting from the time specified by said reservation (Page 5, Paragraph 0050-0054).

The motivation for combining the respective teachings of Murakami, Whipp and Rosenberg are as discussed above in the rejection of claim 1, and incorporated herein.

(D) As per claim 4, Murakami discloses the system wherein the prospective renter accesses the management system at a kiosk located in the parking lot where the particular car is parked (Col.17, lines 14-67).

(E) As per claim 5, Murakami discloses the system wherein the prospective renter accesses the management system over the Internet (Col.17, lines 14-67).

(F) As per claim 6, Whipp discloses the system wherein the key generation system stores a digital key on a storage device provided by a prospective renter (Page5, Paragraphs 0053-0056).

The motivation for combining the respective teachings of Murakami, Whipp and Rosenberg are as discussed above in the rejection of claim 1, and incorporated herein.

(G) As per claim 7, Murakami discloses the system wherein the storage device is a smart card (Col.6, lines 63-67 to Col.7, line 7).

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(H) As per claim 8, Murakami discloses the system wherein the digital key comprises car and user identification (ID) signed by the management system to authenticate the digital key (Col.11, lines 6-67 to Col.12, line 22).

(I) As per claim 9, Murakami discloses the system wherein a renter of a car invalidates a valid digital key upon returning a car to the car rental system and presents an invalidated digital key to the key return system to complete a car return (Col.11, lines 6-67 to Col.12, line 67).

(J) As per claim 10, Murakami discloses the system wherein the invalidation of a valid digital key includes storing car status information relevant to computing by the key return system a receipt for the renter (Col.8, lines 24-64).

(K) As per claim 11, Murakami discloses a computer implemented method for operating a car rental system comprising the steps of

accessing a reservation server by a prospective car renter to reserve a car (See Murakami, Col.6, lines 29-67 to Col.7, line 63);

authenticating the prospective car renter by the reservation server (See Murakami, Col.12, lines 23-67) and,

upon the reservation server successfully authenticating the user, prompting the prospective car renter for the date, time, and location for pickup and return, and the type of car (See Murakami, Col.8, lines 65-67 to Col.9, line 67; Col.10, lines 1-67).

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Murakami does not explicitly disclose checking by the reservation server an availability of a requested car and, if a car is available, creating by the reservation server a digital key by car and user information with a digital signature of the reservation server; and downloading the digital key to a portable storage device, the portable storage device being used to gain access to a rental car.

However, these features are known in the art, as evidenced by Whipp. In particular, Whipp suggests checking by the reservation server an availability of a requested car and, if a car is available, creating by the reservation server a digital key by car and user information with a digital signature of the reservation server (See Whipp, Page 5, Paragraphs 0050-0056); and downloading the digital key to a portable storage device, the portable storage device being used to gain access to a rental car (See Whipp, Page 5, Paragraphs 0050-0056).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Whipp within the system of Murakami with the motivation of providing a car rental system minimizing labor costs and local infrastructure support required to lease a vehicle from a remote site (See Whipp, Page 2, Paragraph 0015).

Murakami and Whipp do not explicitly disclose "without communication between the rental car and the reservation server".

However, this feature is known in the art, as evidenced by Rosenberg. In particular, Rosenberg suggests without communication between the rental car and the

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reservation server (See Rosenberg, Page 6, Paragraph 0071; Page 13, Paragraph 0199).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Rosenberg within the collective teachings of Murakami and Whipp with the motivation of providing no need for exchange of information between the vehicle location system control center and the central computer (See Rosenberg, Page 6, Paragraph 0071).

(L) As per claim 12, Murakami discloses the method wherein the step of accessing the reservation server is performed via a network (Col.17, lines 14-67).

(M) As per claim 13, Whipp discloses the method wherein the network is the Internet (Page 5, Paragraph 0052).

The motivation for combining the respective teachings of Murakami, Whipp and Rosenberg are as discussed above in the rejection of claims 1 and 11, and incorporated herein.

(N) As per claim 14, Whipp discloses the method wherein the step of authenticating a prospective car renter includes the steps of

prompting the prospective car renter to enter a personal identification number (PIN) (Page 7, Paragraphs 0066-0069); and

comparing the entered PIN with a valid PIN for the prospective car renter (Page 7, Paragraphs 0066-0069).

The motivation for combining the respective teachings of Murakami, Whipp and Rosenberg are as discussed above in the rejection of claims 1 and 11, and incorporated herein.

(O) As per claim 15, Whipp discloses the method wherein the step of creating a digital key comprises the steps of

computing a hash of the car renter's valid PIN (Page 6, Paragraphs 0059-0063);
combining car and renter identification with the hashed PIN (Page 6, Paragraphs 0059-0063); and

digitally signing the combined information by said reservation server (Page 5, Paragraphs 0052--0055).

The motivation for combining the respective teachings of Murakami, Whipp and Rosenberg are as discussed above in the rejection of claims 1 and 11, and incorporated herein.

(P) As per claim 16, Whipp discloses the method further comprising the steps of
inserting the portable storage device by a car renter into a slot for
receiving the portable storage device in a rented car (Page 5, Paragraphs 0051-0056);
upon detecting the portable storage device inserted into the slot,
obtaining by an access controller installed in the rented car the digital key
stored on the portable storage device and checking by the access controller
whether the digital key is valid and verifying the signature on the digital key (Page 5,
Paragraphs 0051-0056; Page 6, Paragraphs 0059-0063);

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if the digital key is valid and the signature is verified, the access controller then prompting the car renter to enter his or her identification and checking for correctness of the car renter's identification (Page 6, Paragraphs 0059-0063; Page 8, Paragraphs 0070-0078); and

if the entered identification for the car renter matches a correct identification on the portable storage device, the access controller activating instruments of the car which the car renter is authorized to have access to (Page 6, Paragraphs 0059-0063; Page 8, Paragraphs 0070-0078).

The motivation for combining the respective teachings of Murakami, Whipp and Rosenberg are as discussed above in the rejection of claims 1 and 11, and incorporated herein.

(Q) As per claim 17, Whipp discloses the method further comprising the steps of upon receiving a car renter's request to return a car, prompting the car renter to insert his or her portable storage device into the slot for the portable storage device (Page 5, Paragraphs 0051-0056);

obtaining by the access controller car status information and car identification (Page 6, Paragraphs 0059-0063; Page 8, Paragraphs 0070-0078);

creating by the access controller a return packet by combining car

status information and the current digital key (Page 6, Paragraphs 0059-0063; Page 8, Paragraphs 0070-0078);

signing the return packet by the access controller, appending the car identification to the signed return packet, and saving the signed return packet

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into the portable storage device (Page 2, Paragraph 0020; Page 6, Paragraphs 0059-0063; Page 8, Paragraphs 0070-0078); and

invalidating by the access controller a current digital key (Page 6, Paragraphs 0059-0063; Page 8, Paragraphs 0070-0078).

The motivation for combining the respective teachings of Murakami, Whipp and Rosenberg are as discussed above in the rejection of claims 1 and 11, and incorporated herein.

(R) As per claim 18, Whipp discloses the method further comprising the steps of upon receiving a car renter's request to return a car, retrieving the return packet from the portable storage device (Page 5, Paragraph 0052-0056) ; verifying a signature on the return packet (Page 6, Paragraph 0060-0063); and updating the car status and printing a receipt for the car renter (Page 6, Paragraph 0060-0063).

The motivation for combining the respective teachings of Murakami, Whipp and Rosenberg are as discussed above in the rejection of claims 1 and 11, and incorporated herein.

(S) As per claim 19, Murakami discloses the method wherein the portable storage device is a smart card (Col.7, lines 1-7).

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(T) As per claim 20, Murakami discloses the system wherein each of said fleet of cars has a storage device for storing a record of the digital key (See Murakami, Col.11, lines 6-67 to Col.12, line 67; Col.13, lines 1-67).

Response to Arguments

5. Applicant's arguments filed on 01/12/04 regarding claims 1-19 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed on 01/12/04.

(A) At pages 6-10 of the 01/12/04 response, Applicant argues that the features in the 01/12/04 amendment are not taught by or suggested by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references for the 01/12/04 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Murakami, Whipp and/or Rosenberg, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (Page number 10). One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it

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that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches method of operating a vehicle redistribution system based upon predicted ride demands (6,4653,298), method and apparatus for processing orders from customers in a mobile environment (6,026,375), shared vehicle rental system (5,812,070), car rent system (5,289,369) and car-operated control system for vehicle components (4,477,874).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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V.F
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March 30, 2004

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Alexander Kinnunen
Primary Examiner
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